

REMARKS

Reconsideration and allowance are respectfully requested in light of the above amendments and the following remarks.

Claim 29 has been canceled and claims 31-35 newly added. Support for the features recited in the new claims is provided at least by Figs. 10 and 12(a) and the specification on page 28, lines 2-19. The cancellation of claim 29 obviates the rejection of this claim.

Claim 30 was rejected, under 35 USC §102(b), as being anticipated by the Canon article (hereinafter Canon). It is submitted that this rejection is unwarranted because of the features noted below that are not found in the reference. Further, because Canon does not indicate the month of its publication, it is not possible to determine its precise publication date. Therefore, Applicant reserves the right to file English translations of the present priority application to overcome this reference.

Claim 30 recites that an area of the part of each image to be read by each picture element of an image input device is changeable in accordance with at least one of a dimension of a composite image to be printed and a dimension of each image to be read. The Office Action proposes that Canon discloses this

feature in the "MEMO" section on page 3-20 (see Office Action page 7, second paragraph).

However, the MEMO section discloses only the following. The reduction ratio is automatically set so that the originals fit in the selected copy paper size (Canon page 3-20, MEMO section).

Based on this one sentence in Canon's MEMO, the Office Action concludes that Canon necessarily discloses that an area of the part of each image to be read by each picture element is changeable (i.e., reducible) by automatically adjusting the reduction ratio of each image (Office Action page 7, last paragraph). Applicant submits that this conclusion does not necessarily follow from Canon's disclosure.

Canon does not describe how the image printed to the paper is reduced. If the image is reduced through digital processing of a previously scanned image, then such processing would have no effect on what part of the original image a picture element of the image scanning device was viewing. In other words, an image could be scanned by the Canon copier and digitally stored to memory. Some time later, the stored digital representation of the image could be reduced through digital processing to fit a smaller sheet of paper than that from which the image was scanned. If the operator decides a larger piece of paper is desirable, another digital processing operation on the same

digitally stored representation of the scanned image may be performed to enlarge the printed image. In this scenario, the image is both reduced and enlarged using the same digital representation of the scanned image stored to memory. Since the stored digital representation was obtained from a single scanning operation, the image reduction and enlargement operations had no effect whatsoever on the scanner or its picture elements. Simply put, if the Canon device operates as described above, there is no need for a picture element of the image input device to change, since the reduction ratio is set after the image has been scanned.

The Office Action relies on an implicit finding of inherency to support the rejection of claim 30. However, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) and MPEP §2112, 3rd paragraph. Applicant respectfully submits that the evidence does not support the conclusion that an area of the part of each image read by

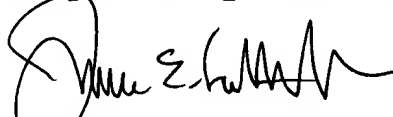
each picture element is necessarily changeable by an adjustment of the reduction ratio set for the image, as proposed in the Office Action.

Accordingly, Applicant submits that Canon does not anticipate the subject matter defined by claim 30. Therefore, allowance of claim 30 and all claims dependent therefrom is warranted.

In view of the above, it is submitted that this application is in condition for allowance and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,



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JEL/DWW/att

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